

REMARKS

Claims 1-13 were examined and reported in the Office Action. Claims 1-4 are rejected. Claims 4, 6-8, 10-13 are amended. New claims 14-16 are added. Claims 1-16 remain. Applicant also submits an information disclosure statement including the prior art cited in the previously submitted search report with a listing on a PTO-1449 form.

Applicant requests reconsideration of the application in view of the following remarks.

I. 37 CFR §1.75(c)

It is asserted in the Office Action that Claims 5-13 are objected under 37 CFR §1.75(c) to as being in improper form because a multiple dependent claim shall not serve as a basis for any other multiple dependent claim. Applicant has amended the claims to overcome the 37 CFR §1.75(c) objection.

Accordingly, withdrawal of the Examiner's objection for Claims 5-13 is respectfully requested.

II. 35 U.S.C. § 102

It is asserted in the Office Action that claim 1 is rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,845,932 issued to Fontaine ("Fontaine"). Applicant respectfully disagrees.

According to MPEP 2131, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.' (Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). 'The identical invention must be shown in as complete detail as is contained in the ... claim.' (Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of

terminology is not required. (In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990))."

Applicant's claim 1 contains the limitations of "[a] safety valve (2) for a chamber (4), the valve comprising a frame (10), a shutter (30) mounted to slide relative to the frame (10), controlled drive means (48, 60) to cause the shutter to open and close an orifice (18) of the chamber, and also release means (46) for causing the shutter to open automatically when pressure in the chamber reaches a predetermined threshold, the valve being characterized in that the release means (46) and the drive means (48, 60) are connected to the shutter in a configuration in which they are parallel with each other.

Fontaine discloses a fluid operated valve for pressurizing fluid as well as opening and closing a valve orifice so the valve can be used in an automatic brake in vehicles under predetermined conditions. It is asserted in the Office Action that the release means and drive means disclosed in Fontaine are connected to a shutter in a configuration such that they are parallel to each other. Applicant respectfully traverses this observation. In Fontaine, the controlled drive means and the release means are not connected to the shutter in a configuration in which they are parallel with each other, but rather are connected to the shutter in a configuration in which they are in series with each other. Applicant notes that in regard to the limitation term in claim 1, "parallel" refers to the configuration of the mounting of the release means and the drive means, not to the geometrical arrangements of these means. Applicant submits two drawings in order to clarify the differences between Fontaine and Applicant's claimed invention. Figure A represents a simplified version of Fontaine's disclosed invention. Figure B represents a simplified version of Applicant's claim 1 limitations (e.g., simplified Figure 7).

As can be seen by the two submitted Figures, Applicant's claimed invention is clearly distinguishable over Fontaine as a configuration "in parallel is not disclosed nor suggested by Fontaine. Applicant's claimed configuration enables the release means to work independently from the drive means, which is clearly not taught, suggested or disclosed by Fontaine.

Therefore, since Fontaine does not disclose, teach or suggest all of Applicant's claim 1 limitations, Applicant respectfully asserts that a *prima facie* rejection under 35 U.S.C. § 102(b) has not been adequately set forth relative to Fontaine. Thus, Applicant's claim 1 is not anticipated by Fontaine.

Accordingly, withdrawal of the 35 U.S.C. § 102(b) rejection for claim 1 is respectfully requested.

III. 35 U.S.C. § 103(a)

It is asserted in the Office Action that Claims 1-3 are rejected in the Office Action under 35 U.S.C. § 103(a), as being unpatentable over U. S. Patent 3,384,101 issued to Melzer ("Melzer") over Fontaine. Applicant respectfully disagrees.

According to MPEP 2142 "[t]o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." (In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). Further, according to MPEP 2143.03, "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974))." "All words in a claim must be considered in judging the patentability of that claim against the prior art." (In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970), emphasis added).

Applicant has asserted above in section II the differences between Applicant's claim 1 limitations with respect to Fontaine.

Melzer discloses a combined safety and release valve to protect a boiler against excess pressure or temperature. Melzer, however, does not teach, disclose or suggest a

safety valve for a chamber where "the release means (46) and the drive means (48, 60) are connected to the shutter in a configuration in which they are parallel with each other."

Neither Melzer, Fontaine, nor the combination of the two, teach, disclose or suggest all the limitations of Applicant's claim 1. Since neither Melzer, Fontaine, nor the combination of the two disclose, teach or suggest all the limitations contained in Applicant's claim 1, as listed above, there would not be any motivation to arrive at Applicant's claimed invention. Thus, Applicant's claim 1 is not obvious over Melzer in view of Fontaine, since a *prima facie* case of obviousness has not been met under MPEP §2142. Additionally, the claims that directly or indirectly depend from Applicant's claim 1, namely claims 2-3, are also not obvious over Melzer in view of Fontaine for the above same reason.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection for Claims 1-3 is respectfully requested.

CONCLUSION

In view of the foregoing, it is believed that all claims now pending, namely 1 - 16, are in condition for allowance and such action is earnestly solicited at the earliest possible date. If there are any fees due in connection with the filing of this response, please charge those fees to our Deposit Account No. 02-2666. If a telephone interview would expedite the prosecution of this Application, the Examiner is invited to contact the undersigned at (310) 207-3800.

PETITION FOR EXTENSION OF TIME

Per 37 C.F.R. 1.136(a) and in connection with the Office Action mailed on June 26, 2003, Applicant respectfully petitions Commissioner for a one (1)- month extension of time, extending the period for response to October 27, 2003 (October 26, 2003 being a Sunday). The Commissioner is hereby authorized to charge payment to Deposit Account No. 02-2666 in the amount of \$110.00 to cover the petition filing fee for a 37 C.F.R. 1.17(a)(1) large entity. A duplicate copy of this sheet is enclosed.

Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP

Dated: October 23, 2003

By: 
Steven Laut, Reg. No. 47,736

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, California 90025
(310) 207-3800

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office, Mail Stop Fee Amendments, Commissioner for Patents, Post Office Box 1450, Alexandria, Virginia 22313-1450, on October 23, 2003.



Jean Svoboda